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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

FUJIMOTO ET AL

Application No. 10/544,234

Art Unit: 2823

Filing date: August 18, 2006

Examiner: Ankush Singal

For: METHOD OF INTERCONNECTING TERMINALS AND  
METHOD OF MOUNTING SEMICONDUCTOR DEVICES

FAX COVER LETTER

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
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The following materials are being transmitted by facsimile  
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2008 in connection with the above-identified application:

Fax cover letter  
Response to restriction requirement

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7 pages

TOTAL

8 PAGES

Respectfully submitted,



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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Official Action mailed on October 16, 2008, containing a restriction requirement, the Applicants traverse the restriction requirement as improper.

The Official Action states that the application contains claims directed to three patentably distinct species. However, the alleged species are not in fact species but are defined by paraphrases of the language from some of the claims (in the case of Species II and III) and by language not found in the claims (in the case of Species I). Essentially, the Official Action is

defining the different claims as being species. However, claims are never species. Species are always specifically different embodiments. See MPEP 806.04(e). Therefore, the species are not properly defined. Moreover, since the present application discloses only two embodiments (the embodiment of Figures 1 - 3 and the embodiment of Figure 12), it is not seen how there can be three different species in the application, as asserted in the Official Action.

According to MPEP 809.02(a), a restriction between species must clearly identify each of the disclosed species to which claims are to be restricted, with the species preferably identified by figure numbers or example numbers. The Official Action contains no association of the alleged species with any figures or examples, and merely attempts to identify the species by a paraphrase of a single claim limitation. This renders it impossible for the Applicants to know what the Examiner considers to be the exact features of a species and therefore makes it impossible to say whether a claim reads on any species. For example, with respect to alleged Species I, page 2 of the Official Action states that "Species I does not include wherein the heating a plurality of the electrically conductive particles .....". Saying that a species does not include a feature does not establish what it does include. A claim to a method of preparing a peanut butter sandwich "does not include wherein the heating a plurality of the electrically conductive particles ..." which the Official Action treats as a definition of Species I, so

perhaps any claim which "does not include wherein ..." would be generic to Species I. However, no one can say, since the species have not been properly define. The failure to adequately define any of the species renders the restriction requirement seriously defective.

The restriction requirement is also defective because the alleged species, to the extent that they are defined, are not mutually exclusive as required by MPEP 806.04(f). For example, the feature which the Official Action considers to define Species I and the feature which the Official Action considers to define Species III are both features of the embodiment illustrated in Figures 1 - 3. Similarly, in the embodiment of Figures 1 - 3, if an electrically conductive resin composition is applied to terminals so as to bulge slightly laterally outwards from the space between opposing terminals prior to heating, the feature which the Official Action considers to define Species II and the feature which the Official Action considers to define Species III will both be features of the same embodiment. Accordingly, the restriction requirement is treating different features of the very same embodiment as different species, which is improper.

As for the rationale as to why the alleged species are independent or distinct, page 3 of the Official Action asserts that the species are independent or distinct "because claims to the different species recite the mutually exclusive characteristics of such species". As set forth in the preceding

paragraph, there is nothing mutually exclusive about the features of alleged Species I and those of alleged Species III, and there is also nothing mutually exclusive about the features of alleged Species II and those of alleged Species III. As defined by the Official Action, alleged Species I and alleged Species II do have mutually exclusive characteristics, but contrary to the statement in the Official Action, there are no claims which recite the mutually exclusive characteristics. Specifically, there is no claim which recites the language which the Official Action considers to characterize Species I.

As set forth in MPEP 808.02, in order to establish reasons for insisting upon restriction, an examiner must explain why there would be a serious burden on the examiner if restriction were not required. The Examiner has failed to do so. The middle of page 3 of the Official Action nominally gives reasons why a burden exists, but none of these reasons withstand scrutiny. The Official Action states that the species require a different field of search, but the Official Action has not shown that the different alleged species have different classifications and would in fact require a different field of search. The Official Action also states that "the species are likely to raise different non-prior art issues"; however, this assertion could be made about any two claims in an application and cannot be considered any sort of burden on the Examiner.

Since the Examiner did not previously issue a restriction

requirement in connection with the present application, it is assumed that the restriction requirement is a result of the amendment filed on July 31, 2008, which added new claims 16 - 21. Of these claims, claim 17 is specific to a single embodiment (the embodiment of Figures 1 - 3), and claims 20 and 21 are specific to the embodiment of Figure 12. Since the application already contained claims specific to the embodiment of Figure 12 but did not contain any claims specific to the embodiment of Figures 1 - 3, it appears that the addition of claim 17 to the application was the cause of the restriction requirement. Therefore, it is important to consider the origin of claim 17. In an interview held at the PTO with Examiner Singal and SPE Matthew Smith on October 9, 2007, Examiner Smith suggested amending the claims to state that after curing of a resin component, no electrically conductive particles remain between adjoining pairs of terminals. New claim 17 was added in accordance with that suggestion. Since the very existence of claim 17 in the application is the result of an examiner's suggestion, it is inappropriate to now assert that the presence of this claim imposes any sort of burden in carrying out examination of the application.

For all of the above reasons, the restriction requirement is improper and should be withdrawn. However, since the Applicants are required to elect a single one of the species, the Applicants elect with traverse Species II, which includes the feature that "a plurality of the electrically conductive particles in the composition move from outside the spaces between the opposing

terminals move into the spaces between the opposing terminals and accumulate in the spaces together with electrically conductive particles already inside the spaces prior to the heating by melting and agglomeration". As set forth above, this feature can be found in more than one embodiment of the invention, but it appears most prominently in the embodiment illustrated by Figure 12, so it will be assumed that Species II was meant to correspond to that embodiment. All of claims 8 - 16 and 18 - 21 read on that embodiment. Of these claims, claims 8, 9, 11, 14, 15, 16, 18, and 19 are generic.

Favorable consideration is respectfully requested.

Respectfully submitted,



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Signature Michael Tobias  
Michael Tobias